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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,143	09/12/2003	Joseph Gaikoski	P-B099	7743
29222	7590	08/13/2007		
W. THOMAS TIMMONS 1320 PRUDENTIAL DRIVE SUITE 208 DALLAS, TX 75235-4117			EXAMINER PLUCINSKI, JAMISUE A	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 08/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,143

Applicant(s)

GAIKOSKI, JOSEPH

Examiner

Jamisue A. Plucinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-39 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 6, 7, 12, 13, 18, 19, 24, 25, 30, 31, 36 and 37-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Allen et al. (US 2005/0187885).

4. With respect to Claims 1, 7, 13, 19, 25 and 31: Allen discloses a method and system for delivering gifts/items/discs (Paragraph 0023) of predetermined size and a maximum weight comprising:

- a. Selecting delivery boxes, each selected of the proper size for a gift/item/disc of a predetermined size (Paragraph 0046);
- b. Providing means for placing a delivery name and address on each box (Paragraph 0025);
- c. Affixing a delivery indicia on each box of the proper denomination for the maximum weight, plus the weight of the box (Paragraphs 0027 and 0034);
- d. Placing a purchased gift/item/disc of the predetermined size and no more than the maximum weight into a box (Allen discloses the sales unit can include multiple items,

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and discloses that the weight of the sales unit is known and used for calculation for the package, When calculating postage, it is done on weight, therefore if it weighed more, it would cost more, therefore the postage that is calculated is considered to be for only those items and considered to be for the maximum weight of the items, Paragraph 0034);

e. Closing the box (Paragraph 0025);

f. Placing the delivery name and address on the box (Paragraph 0025);

g. Delivering the closed box to the carrier (Paragraphs 0022, 0025, 0029).

5. With respect to Claims 6, 12, 18, 24, 30 and 36: Allen discloses providing a gift card for enclosing in or attaching to the box (Paragraph 0025).

6. With respect to Claims 37, 38 and 39: Allen discloses the use of Delivery boxes (Paragraphs 0037 and 0038) for mailing gifts/items/discs (Paragraphs 0021-0025), with pre-paid delivery based on the item and its weight (Paragraphs 0027 and 0046).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 3, 8, 9, 14, 15, 20, 21, 26, 27, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (US 2005/0187885).

9. With respect to: Allen discloses the gifts/item/discs are compact discs or DVDs (Paragraph 0023), where the carrier is a postal carrier (paragraphs 0022 and 0029), the indicia is

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postal indicia (Paragraph 0034) which is pre-paid, based on the item (Paragraph 0046).

However, Allen fails to specifically disclose the discs are in jewel cases, with either one or two discs. Official Notice is taken that is old and well known within the electronic arts, that disks come in jewel cases and there are many jewel cases which accommodate two discs (albums which are a 2-disk set). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made, to mail the disks of Allen in jewel cases in order to protect the disks from scratches. Allen discloses the postage is based on the item, therefore a 2-Disc DVD or CD, the postage amount would be for the weight of 2 discs.

10. Claims 4, 5, 10, 11, 16, 17, 22, 23, 28, 29, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of McClung et al. (US 2004/0059636).

11. With respect to Claims 4, 5, 10, 11, 16, 17, 22, 23, 28, 29, 34 and 35: Allen discloses the use of the post office as the carrier, the examiner considers the USPS to be a freight carrier and a ship carrier, due to the fact that it ships packages all the way across the continent, and therefore considered to be freight. Allen discloses the use of labels which are affixed to boxes, which contain a list of items therein, however specifically fails to disclose the indicia being applied to a waybill which is then affixed to the box. McClung discloses the use of a shipping service, which creates waybills containing carrier information (which the examiner considers to be indicia), and attaches them to the outside of boxes (See Paragraphs 0090-0094). The use of waybills having shipping information and packing information, which is then attached to the outside of packages being shipped, is old and well known in the art. This is done when ordering things remotely, such as over the internet, or large boxed items in warehouses, where reboxing

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the item to add a packaging slip is burdensome, therefore the packing slip is attached to the outside of the original box. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have the delivery indicia be applied to a waybill, and the waybill being attached to the box, as disclosed by McClung, and well known in the art, in order to provide shipping/delivery information along with the package, for larger items. (See McClung, pages 7 and 8)

Interference

12. The request for interference filed 5/14/07 is acknowledged. However, examination of this application has not been completed as required by 37 CFR 41.102(a). Consideration of a potential interference is premature. See MPEP § 2303.

Response to Arguments

13. Applicant's arguments filed 5/14/07 have been fully considered but they are not persuasive.

14. With respect to Applicant's argument that Allen is not a proper reference: When a 102(e) reference is used, the filing date may be used for either a US Patent, or a US Pre-Grant Publication, and its earliest date in the chain of continuity. A provisional application may be used as the 102(e) date as long as the information relied can be found in the provisional and the provisional date is at least one day before the effective filing date of the application. The examiner has supplied a copy of the provisional. The applicant has attempted to enact an interference for the claims, however as stated above, the request for an interference is premature,

being that neither set of claims have been indicated as allowable. If the applicant has conception and can show due diligence for the time period before the provisional of the Allen reference to constructive reduction to practice, the examiner suggest filing a 131 Affidavit to overcome the reference, as opposed to an Interference as this time.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

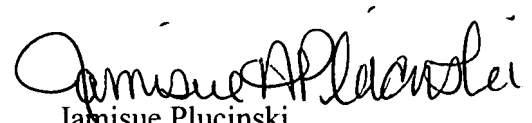
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Janisue Plucinski
Primary Examiner
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